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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,490	07/26/2001	Michael Wayne Brown	AUS920010396US1	6710

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EXAMINER

GOLD, AVI M

ART UNIT PAPER NUMBER

2157

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/915,490

Applicant(s)

BROWN ET AL.

Examiner

Avi Gold

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The amendment received on February 7, 2005 has been entered and fully considered.

Response to Amendment

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-5, 8-16, 19-27, and 30-56 are rejected under 35 U.S.C. 102(e) as being anticipated by Chang et al., U.S. Patent No. 6,105,012.

Chang teaches the invention as claimed including a method and apparatus for securely transmitting transactions from an application program (see abstract).

Regarding claims 1 and 25, Chang teaches a method and program for recording a messaging session, said method comprising the steps of:

applying a distinguishable watermark to a plurality of message entries within a messaging session (fig. 1, fig. 2, col. 4, lines 21-31, Chang discloses messages given a digital signature); and

recording said plurality of messaging entries with said distinguishable watermark applied, such that an origin of said plurality of message entries traceable according to said distinguishable watermark (col. 5, lines 55-67, Chang discloses an audit trail that keeps track of users and their digital signatures on messages and a digital signature signifying a particular user which identifies the origin of the message).

Regarding claim 2, Chang teaches the method for recording a messaging session according to claim 1, said method further comprising the step of:

applying said distinguishable watermark and recording said plurality of messaging entries at a messaging server system communicatively connected via a network to a plurality of client systems accessible to a plurality of users (fig. 1, fig. 2, col. 1, lines 55-65, Chang discloses a group of users associated with client computers interconnected by a network to a server that applies and tracks the messages including the digital signatures).

Regarding claim 3, Chang teaches the method for recording a messaging session according to claim 1, said method further comprising the step of:

applying said distinguishable watermark and recording said plurality of messaging entries at a separate one of a plurality of client systems communicatively connected via a network to said plurality of client systems accessible to a plurality of users (fig. 1, fig. 2, col. 1, lines 55-65, col. 8, lines 31-38, Chang discloses a digital signature created on the client computer).

Regarding claims 4 and 26, Chang teaches the method and program for recording a messaging session according to claims 1 and 25, said method further comprising the step of:

applying a plurality of distinguishable watermarks, each associated with a separate one of a plurality of users, to said plurality of message entries within a messaging session (col. 5, lines 55-67).

Regarding claims 5, 16, and 27, Chang teaches the method, system, and program for recording a messaging session according to claims 1, 14, and 25, said step of applying a distinguishable watermark further comprising the step of:

applying a textual watermark to said plurality of message entries within said messaging session (col. 4, lines 21-31).

Regarding claims 8, 19, and 30, Chang teaches the method, system, and program for recording a messaging session according to claims 1, 14, and 25, said method, system, and program further comprising the step of:

transmitting said recording of said plurality of messaging entries with a plurality of watermarks applied to said plurality of users, wherein each of said plurality of watermarks corresponds to one from among a plurality of users participating in said messaging session (col. 4, lines 21-31, col. 5, lines 55-67, col. 8, lines 59-66, Chang

discloses processing requests and transactions from the user which includes their digital signatures).

Regarding claims 9, 20, and 31, Chang teaches the method, system, and program for recording a messaging session according to claims 1, 14, and 25, said method, system, and program further comprising the step of:

storing said recording in a log file repository for tracing said origin of said plurality of message entries according to said distinguishable watermark (col. 5, lines 55-67, Chang discloses an audit trail).

Regarding claims 10, 21, and 32, Chang teaches the method, system, and program for recording a messaging session according to claims 1, 14, and 25, said method, system, and program further comprising the step of:

tracing a separate one of said plurality of message entries of said messaging session by comparing said separate one of said plurality of message entries with a plurality of watermarked recordings stored according to messaging session (col. 2, line 62 – col. 3, line 4, Chang discloses the storage of a users public key to verify a digital signature).

Regarding claims 11, 22, and 33, Chang teaches the method, system, and program for recording a messaging session according to claims 1, 14, and 25, said method, system, and program further comprising the step of:

tracing a separate one of said plurality of message entries a separate one of a plurality of users by comparing said separate one of said plurality of entries with a plurality of watermarked recordings stored according to said plurality users (col. 2, line 62 – col. 3, line 4).

Regarding claims 12, 23, and 34, Chang teaches the method, system, and program for recording a messaging session according to claims 1, 14, and 25, said method, system, and program further comprising the step of:

applying said distinguishable watermark in response to a user request to record said plurality of messaging entries with watermarking (col. 2, lines 19-29, Chang discloses a message digitally signed when requested).

Regarding claims 13, 24, and 35, Chang teaches the method, system, and program for recording a messaging session according to claims 1, 14, and 25, said method, system, and program further comprising the step of:

applying said distinguishable watermark to a plurality of message entries already recorded for said messaging session (col. 2, lines 19-29, col. 4, lines 21-31).

Regarding claim 14, Chang teaches a system for recording a messaging session, said system comprising:

a messaging server communicatively connected to a network (fig. 1, fig. 2, col. 1, lines 55-65);

means for applying a distinguishable watermark to a plurality of message entries within a messaging session (fig. 1, fig. 2, col. 4, lines 21-31); and

means for recording said plurality of messaging entries with said distinguishable watermark applied, such that an origin of said plurality of message entries is traceable according to said distinguishable watermark (col. 5, lines 55-67).

Regarding claim 15, Chang teaches the system for recording a messaging session according to claim 14, said system further comprising:

means for applying a plurality of distinguishable watermarks, each associated with a separate one of a plurality of users, to said plurality of message entries within a messaging session (fig. 1, fig. 2, col. 1, lines 55-65, col. 5, lines 55-67, col. 8, lines 31-38).

Regarding claims 36, 41, and 46, Chang teaches the method, system, and program for participating in a messaging session, said method, system, and program further comprising the step of:

participating in a messaging session by receiving a plurality of messaging entries from a plurality of users participating in said messaging session (fig. 1, fig. 2, col. 1, lines 55-65); and

receiving a recording of said messaging session, wherein said plurality of message entries for said messaging session are watermarked, such that use of said

recording of said messaging session is traceable according to a watermark (col. 5, lines 55-67).

Regarding claims 37, 42, and 47, Chang teaches the method, system, and program for participating in a messaging session according to claims 36, 41, and 46, said method, system, and program further comprising the step of:

requesting said recording of said messaging session with watermarking of said plurality of message entries (col. 2, lines 19-29, col. 4, lines 21-31).

Regarding claims 38, 43, and 48, Chang teaches the method, system, and program for participating in a messaging session according to claims 1, 14, and 25, said method, system, and program further comprising the step of:

watermarking said recording of said messaging session (col. 5, lines 55-67).

Regarding claims 39, 44, and 49, Chang teaches the method, system, and program for participating in a messaging session according to claims 1, 14, and 25, said method, system, and program further comprising the step of:

participating said messaging session by transmitting watermarked message entries for access by said plurality of users participating in said messaging session (col. 4, lines 21-31, col. 5, lines 55-67, col. 8, lines 59-66).

Regarding claims 40, 45, and 50, Chang teaches the method, system, and program for participating in a messaging session according to claims 1, 14, and 25, said method, system, and program further comprising the step of:

submitting a watermarked entry to be traced according to said watermarking (col. 5, lines 55-67).

Regarding claims 51 and 53, Chang teaches a method and program for protecting received message entries, said method and program comprising the steps of:

receiving a message entry in association with a messaging session at a client messaging system (fig. 1, fig. 2, col. 1, lines 55-65, col. 4, lines 21-31); and

applying a watermark to said message entry, such that an origin of said message entry is traceable to said client messaging system (col. 5, lines 55-67).

Regarding claims 52, Chang teaches a system for protecting received message entries, said system comprising:

a client messaging system communicatively connected to a network to a messaging session;

means for receiving a message entry in association with said messaging session at said client messaging system (fig. 1, fig. 2, col. 1, lines 55-65, col. 4, lines 21-31); and

means for applying a watermark to said message entry, such that an origin of said message entry is traceable to said client messaging system (col. 5, lines 55-67).

Regarding claims 54 and 56, Chang teaches a method and program for protecting message transmissions, said method and program comprising the step of:

- detecting a new message entry entered at a client messaging system; and
- applying a watermark to said new message entry prior to transmission for distribution within a messaging session, such an origin of said new message entry is traceable to said client messaging system (fig. 1, fig. 2, col. 4, lines 21-31, col. 5, lines 55-67).

Regarding claim 55, Chang teaches a system for protecting message transmissions, said system comprising:

- a client messaging system communicatively connected to a network to a messaging session;
- means for detecting a new message entry entered at said client messaging system; and
- means for applying a watermark to said new message entry prior to transmission for distribution within said messaging session, such that an origin of said new message entry is traceable to said client messaging system (fig. 1, fig. 2, col. 1, lines 55-65, col. 4, lines 21-31, col. 5, lines 55-67).

3. Claims 6, 7, 17, 18, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang in view of Rodriguez et al., U.S. Patent No. 6,650,761.

Chang teaches the invention substantially as claimed including a method and apparatus for securely transmitting transactions from an application program (see abstract).

As to claims 6, 7, 17, 18, 28, and 29, Chang teaches the method, system, and program of claims 1, 14, and 25.

Chang fails to teach the limitation further including the use of a graphical and audible watermark.

However, Rodriguez teaches systems using such optical interfaces to control computers, and to navigate over or act as portals on networks (see abstract).

Rodriguez teaches the use of an audio watermark (col. 44, lines 66-67) and a graphical watermark (col. 53, lines 51-58).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Chang in view of Rodriguez to use a graphical and audible watermark. One would be motivated to do so because it would allow for different options of visible watermarking.

Response to Arguments

4. Applicant's arguments, see pages 19-36, filed February 7, 2005, with respect to the rejection(s) of claim(s) 1-56 under Cotten and Zhao have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Chang et al.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 6,606,393 to Xie et al.

U.S. Pat. No. 6,754,822 to Zhao

U.S. Pat. No. 6,356,935 to Gibbs

U.S. Pat. No. 6,357,006 to Pham et al.

U.S. Pat. No. 6,625,734 to Marvit et al.

U.S. Pat. No. 5,828,835 to Isfeld et al.

U.S. Pat. No. 6,564,322 to Jameson et al.

U.S. Pat. No. 4,569,015 to Dolev et al.

U.S. Pat. No. 6,760,443 to Lacy et al.

U.S. Pat. No. 6,330,590 to Cotten

U.S. Pat. No. 6,754,822 to Zhao

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Avi Gold whose telephone number is 571-272-4002.

The examiner can normally be reached on M-F 8:00-5:30 (1st Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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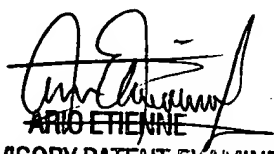
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Avi Gold

Patent Examiner

Art Unit 2157

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